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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,311	02/28/2002	Uwe-Peter Weigmann	691178.90011	7589

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QUARLES & BRADY LLP  
411 E. WISCONSIN AVENUE  
SUITE 2040  
MILWAUKEE, WI 53202-4497

EXAMINER

OJINI, EZIAMARA ANTHONY

ART UNIT	PAPER NUMBER
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3723

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/085,311

Applicant(s)

WEIGMANN ET AL.

Examiner

Anthony Ojini

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 February 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All   b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the expressions "the tool is reset to a smaller size" in claim 5, and "wherein the smoothing of the peaks of the surface structure takes place by using different tool" in claim 10, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

**In claim 1**, line 1, the expression "the surface of a bore" lacks antecedent basis;  
in line 5, the expression "the ratio of the stroke speed" lacks antecedent basis;  
in line 5, the expression "the rotational speed" lacks antecedent basis;  
and in line 6, the expression "the normal ratio" lacks antecedent basis.

**In claim 1**, it is unclear what steps applicant is claiming.

Art Unit: 3723

In claim 7, the expression "wherein, before or during remachining with the higher speed" is unclear which limitation applicant is referring to.

In claim 8, the expression "the peaks of the surface structure" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4,6,7,8,9,11, as well as understood, are rejected under 35

U.S.C. 102(b) as being anticipated by Nagel (6,012,973).

**With respect to claims 1-4,6,** Nagel discloses a method of honing inner surface (11) of a cylinder (12) with honing tool (20) comprising the following steps: machining the said inner surface (11) of a cylinder (12) with a honing tool (20) driven both in a rotary (18) and in an axially reciprocating (19) manner (i.e. one stroke and return stroke); and increasing a ratio of axially reciprocating speed to the rotational speed of the tool compared with the normal ratio honing tool during machining (see col. 3, lines 18-33 & figure 1).

**With respect to claim 7,** Nagel discloses wherein before remachining with the higher speed, there is a honing tool infeed (see fig.1)

**With respect to claims 8,9,** Nagel discloses wherein the peaks of the surface of the inner cylinder are smoothed with aid of the honing tool (20).

**With respect to claim 11**, Nagel discloses wherein honing comprises plurality of axially reciprocating strokes (see col. 3, lines 18-21 & fig. 1).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nagel.

**With respect to claim 5**, Nagel fails to disclose wherein, prior to the remachining return stroke, the tool is reset to a smaller size.

It would have been an obvious matter of design choice to provide apparatus of Nagel with a smaller size, since such a modification would have involved a mere change in the size of a component. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955).

**With respect to claim 10**, Nagel fails to disclose wherein the smoothing of the peaks of the surface structure takes place by using a different tool.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide apparatus of Nagel with a different tool for smoothing of the peaks of the surface structure, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the

Art Unit: 3723

intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416. See also *Ballas Liquidating Co. v. Allied industries of Kansas, Inc.* (DC Kans) 205 USPQ 331.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Blake, Hyatt, Roitner, Sandhof, Lin et al., Nagel et al, and Higashikawa disclose honing tool respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Ojini whose telephone number is 703 305 3768. The examiner can normally be reached on 7.30 to 5.00 Tuesday-Friday with every other Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308 2687. The fax phone numbers for the organization where this application or proceeding is assigned are 703 308 3590 for regular communications and 703 746 3277 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1148.



AO  
August 14, 2003